

05-03-04

(Rel.95-7/03 Pub.605)

FORM 23-10

23-39

DHC  
Director's OfficePractitioner's Docket No. 5147.21**PATENT****IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of: **Gayle Eysenring Jenkins**  
 Application No.: **60 /468,969** Group No.: (Provisional Application)  
 Filed: **5/9/03** Examiner:  
 For: **BOTTLE HARNESS/DRINK DEPUTY**

**Mail Stop Conversion**  
**Commissioner for Patents**  
**P.O. Box 1450, Alexandria, VA 22313-1450**

**REQUEST FOR CONVERSION OF PROVISIONAL TO  
NONPROVISIONAL APPLICATION**  
 (37 C.F.R. § 1.53(c)(3))

**WARNING:** Under 35 U.S.C. 154(b), the term of a nonprovisional application resulting from the conversion of a provisional application pursuant to 35 U.S.C 111(b)(5) will be measured from the original filing date of the provisional application (which is the filing date accorded the nonprovisional application resulting from the conversion). Such patent term implications of converting a provisional application into a nonprovisional application pursuant to 111(b)(5) should be carefully considered against the alternative of simply filing a nonprovisional application within twelve months of the filing date of the provisional application and claiming the benefit of the provisional application under 35 U.S.C. 119(e). Notice of March 10, 2000, 65 Fed Reg 14865, at 14868.

**WARNING:** A request for conversion must be filed prior to the earliest of: (1) abandonment of the provisional application; or (2) expiration of twelve months after the filing date of the provisional application. 37 CFR 1.53(c). But note, 35 U.S.C. 119(e) provides that "[i]f the day that is 12 months after the filing date of a provisional application falls on a Saturday, Sunday, or Federal Holiday within the District of Columbia, the period of pendency of the provisional application shall be extended to the next succeeding secular or business day."

**CERTIFICATION UNDER 37 C.F.R. §§ 1.8(a) and 1.10\***  
 (When using Express Mail, the Express Mail label number is mandatory;  
 Express Mail certification is optional.)

I hereby certify that, on the date shown below, this correspondence is being:

**MAILING**

deposited with the United States Postal Service in an envelope addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450

**37 C.F.R. § 1.8(a)****37 C.F.R. § 1.10 \***

with sufficient postage as first class mail.  as "Express Mail Post Office to Addressee"

Mailing Label No. EV234619181 (Mandatory)

**TRANSMISSION**

facsimile transmitted to the Patent and Trademark Office, (703) \_\_\_\_\_

Gloria Gruetzmacher  
 Signature

Gloria Gruetzmacher

(type or print name of person certifying)

\* Only the date of filing (§ 1.6) will be the date used in a patent term adjustment calculation, although the date on any certificate of mailing or transmission under § 1.8 continues to be taken into account in determining timeliness. See § 1.703(f). Consider "Express Mail Post Office to Addressee" (§ 1.10) or facsimile transmission (§ 1.6(d)) for the reply to be accorded the earliest possible filing date for patent term adjustment calculations.

(Request For Conversion of Provisional to Nonprovisional Application (37 C.F.R. § 1.53(c)(3)) [23-107294-1]

05/06/2004 AHOANDAF1 00000047 60468969

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01 FC:2001  
02 FC:1460

385.00 OP  
130.00 OP

Adjustment date: 05/06/2004 AHOANDAF1 00000047 60468969  
01 FC:2001  
385.00 OP

07/23/2004 JTIPETT 00000003 10713932

01 FC:2001

## **REQUEST FOR CONVERSION**

1. Please convert the above identified provisional application filed to a nonprovisional application under 37 C.F.R. § 1.53(c)(3).

*NOTE: The conversion of a provisional application to a nonprovisional application will not result in either the refund of any fee properly paid in the provisional application or the application of any such fee to the filing fee, or any other fee, for the nonprovisional application. 37 CFR 1.53(c)(3). Thus, the conversion of a provisional application will not result in any savings in filing fees over the filing of a nonprovisional application claiming the benefit under 35 U.S.C. 119(e) and 37 CFR 1.78 of the earlier provisional application.*

## **AMENDMENTS**

2. Attached is an amendment to the provisional application as follows:

*NOTE: Under 37 CFR 1.53(c) an amendment including at least one claim as prescribed by the second paragraph of 35 U.S.C. 112 must be filed in order to convert a nonprovisional application, unless the provisional application otherwise contains at least one claim.*

- Amendment
- Claims
- Information disclosure statement (37 C.F.R. Section 1.98)
  - Form PTO-1449 (PTO/SB/08A and 08B)
  - Other

## **BENEFIT OF PRIOR U.S. APPLICATION(S) (35 U.S.C. §§ 119(e), 120, OR 121)**

*NOTE: A nonprovisional application may claim an invention disclosed in one or more prior filed copending nonprovisional applications or copending international applications designating the United States of America. In order for a nonprovisional application to claim the benefit of a prior filed copending nonprovisional application or copending international application designating the United States of America, each prior application must name as an inventor at least one inventor named in the later filed nonprovisional application and disclose the named inventor's invention claimed in at least one claim of the later filed nonprovisional application in the manner provided by the first paragraph of 35 U.S.C. Section 112. Each prior application must also be:*

- (i) An international application entitled to a filing date in accordance with PCT Article 11 and designating the United States of America; or*
- (ii) Complete as set forth in Section 1.51(b); or*
- (iii) Entitled to a filing date as set forth in Section 1.53(b) or Section 1.53(d) and include the basic filing fee set forth in Section 1.16; or*
- (iv) Entitled to a filing date as set forth in Section 1.53(b) and have paid therein the processing and retention fee set forth in Section 1.21(l) within the time period set forth in Section 1.53(f).*

*37 C.F.R. Section 1.78(a)(1).*

*NOTE: If the new application being transmitted is a divisional, continuation or a continuation-in-part of a parent case, or where the parent case is an International Application which designated the U.S., or benefit of a prior provisional application is claimed, then check the following item and complete and attach ADDED PAGES FOR NEW APPLICATION TRANSMITTAL WHERE BENEFIT OF PRIOR U.S. APPLICATION(S) CLAIMED.*

**(Request For Conversion of Provisional to Nonprovisional Application (37 C.F.R. § 1.53(c)(3)) [23-10]**  
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**WARNING:** If an application claims the benefit of the filing date of an earlier filed application under 35 U.S.C. 120, 121 or 365(c), the 20-year term of that application will be based upon the filing date of the earliest U.S. application that the application makes reference to under 35 U.S.C. 120, 121 or 365(c). (35 U.S.C. 154(a)(2) does not take into account, for the determination of the patent term, any application on which priority is claimed under 35 U.S.C. 119, 365(a) or 365(b).) For a c-i-p application, applicant should review whether any claim in the patent that will issue is supported by an earlier application and, if not, the applicant should consider canceling the reference to the earlier filed application. The term of a patent is not based on a claim-by-claim approach. See Notice of April 14, 1995, 60 Fed. Reg. 20,195, at 20,205.

3.  The new application being transmitted claims the benefit of prior U.S. application(s). Enclosed are ADDED PAGES FOR NEW APPLICATION TRANSMITTAL WHERE BENEFIT OF PRIOR U.S. APPLICATION(S) CLAIMED.

### **DECLARATION OR OATH (INCLUDING POWER OF ATTORNEY)**

**NOTE:** A newly executed declaration is not required in a continuation or divisional application provided the prior nonprovisional application contained a declaration as required, the application being filed is by all or fewer than all the inventors named in the prior application, there is no new matter in the application being filed, and a copy of the executed declaration filed in the prior application (showing the signature or an indication thereon that it was signed) is submitted. The copy must be accompanied by a statement requesting deletion of the names of person(s) who are not inventors of the application being filed. If the declaration in the prior application was filed under § 1.47 then a copy of that declaration must be filed accompanied by a copy of the decision granting § 1.47 status or, if a nonsigning person under § 1.47 has subsequently joined in a prior application, then a copy of the subsequently executed declaration must be filed. See 37 C.F.R. § 1.63(d)(1)-(3).

**NOTE:** A declaration filed to complete an application must be executed, identify the specification to which it is directed, identify each inventor by full name, including the family name, and at least one given name without abbreviation together with any other given name or initial, and the residence, post office address and country of citizenship of each inventor, and state whether the inventor is a sole or joint inventor. 37 C.F.R. § 1.63(a)(1)-(4).

**NOTE:** A The inventorship of a nonprovisional application is that inventorship set forth in the oath or declaration as prescribed by § 1.62, except as provided for in § 1.53(d)(4) and § 1.63(d). If an oath or declaration as prescribed by § 1.63 is not filed during the pendency of a nonprovisional application, the inventorship is that inventorship set forth in the application papers filed pursuant to § 1.53(b), unless a petition under this paragraph accompanied by the fee set forth in § 1.17(i) is filed supplying or changing the name or names of the inventor or inventors. 37 C.F.R. § 1.41(a)(1).

4.  Enclosed

Executed by:

(check **all** applicable boxes)

- inventor(s).
- legal representative of inventor(s). 37 C.F.R. § 1.42 or 1.43.
- joint inventor or person showing a proprietary interest on behalf of inventor who refused to sign or cannot be reached.
- This is the petition required by 37 C.F.R. § 1.47 and the statement required by 37 C.F.R. § 1.47 is also attached. See item 10 below for fee.

- Not Enclosed.

NOTE: Where the filing is a completion in the U.S. of an International Application, or where the completion of the U.S. application contains subject matter in addition to the International Application, the application may be treated as a continuation or continuation-in-part, as the case may be, utilizing ADDED PAGE FOR NEW APPLICATION TRANSMITTAL WHERE BENEFIT OF PRIOR U.S. APPLICATION CLAIMED.

- Application is made by a person authorized under 37 C.F.R. § 1.41 on behalf of all the above named inventor(s).

(The declaration or oath, along with the surcharge required by 37 C.F.R. § 1.16(e), can be filed subsequently).

- Showing that the filing is authorized. (not required unless called into question. 37 C.F.R. § 1.41(d))

### INVENTORSHIP STATEMENT

**WARNING:** If the named inventors are each not the inventors of all the claims an explanation, including the ownership of the various claims at the time the last claimed invention was made, should be submitted.

5. The inventorship for all the claims in this application are:

- The same.

or

- Not the same. An explanation, including the ownership of the various claims at the time the last claimed invention was made,  
 is submitted.  
 will be submitted.

### CERTIFIED COPY

6. Certified copy(ies) of application(s)

Country	Appln. no.	Filed
Country	Appln. no.	Filed
Country	Appln. no.	Filed

from which priority is claimed

- is (are) attached.  
 will follow.

NOTE: The foreign application forming the basis for the claim for priority must be referred to in the oath or declaration. 37 C.F.R. §§ 1.55(a) and 1.63.

NOTE: This item is for any foreign priority for which the application being filed directly relates. If any parent U.S. application or International Application from which this application claims benefit under 35 U.S.C. 120 is itself entitled to priority from a prior foreign application, then complete the appropriate item on the ADDED PAGES FOR NEW APPLICATION TRANSMITTAL WHERE BENEFIT OF PRIOR U.S. APPLICATION(S) CLAIMED.

(Request For Conversion of Provisional to Nonprovisional Application (37 C.F.R. § 1.53(c)(3)) [23-10]  
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**FEE CALCULATION (37 C.F.R. § 1.16)****7. A.  Regular application**

Claims	Number Filed	CLAIMS AS FILED			Basic Fee 37 C.F.R. § 1.16(a)
		Basic Fee Allowance	Number Extra	Rate	
Total Claims (37 C.F.R. § 1.16(c))	- 20 =		x	\$ 18.00	\$750.00 770.00
Independent Claims (37 C.F.R. § 1.16(b))	- 3 =		x	\$84.00	
Multiple Dependent Claim(s), if any (37 C.F.R. § 1.16(d))			+	\$280.00	

- Amendment cancelling extra claims is enclosed.
- Amendment deleting multiple-dependencies is enclosed.
- Fee for extra claims is not being paid at this time.

*NOTE: If the fees for extra claims are not paid on filing they must be paid or the claims cancelled by amendment, prior to the expiration of the time period set for response by the Patent and Trademark Office in any notice of fee deficiency. 37 C.F.R. § 1.16(d).*

Filing Fee Calculation \$ 770.00

**B.  Design application (\$330.00—37 C.F.R. § 1.16(f))**

Filing Fee Calculation \$ \_\_\_\_\_

**C.  Plant application (\$520.00—37 C.F.R. § 1.16(g))**

Filing Fee Calculation \$ \_\_\_\_\_

**8. Small Entity Statement(s)**

- Statement(s) that this is a filing by a small entity under 37 C.F.R. §§ 1.9 and 1.27 is (are) attached.

**WARNING:** "Status as a small entity must be specifically established in each application or patent in which the status is available and desired. Status as a small entity in one application or patent does not affect any other application or patent, including applications or patents which are directly or indirectly dependent upon the application or patent in which the status has been established. The re filing of an application under § 1.53 as a continuation, division, or continuation-in-part (including a continued prosecution application under § 1.53(d)), or the filing of a reissue application requires a new determination as to continued entitlement to small entity status for the continuing or reissue application. A nonprovisional application claiming benefit under 35 U.S.C. 119(e), 120, 121, or 365(c) of a prior application, or a reissue application may rely on a statement filed in the prior application or in the patent if the nonprovisional application or the reissue application includes a reference to the statement in the prior application or in the patent or includes a copy of the statement in the prior application or in the patent and status as a small entity is still proper and desired. The payment of the small entity basic statutory filing fee will be treated as such a reference for purposes of this Section." 37 C.F.R. § 1.28(a)(2).

**WARNING:** "Small entity status must not be established unless the person or persons signing the . . . statement can unequivocally make the required self-certification." M.P.E.P. § 509.03, 7th ed. (emphasis added).

(complete the following, if applicable)

- Status as a small entity was claimed in prior application 60 A68,969, filed on 5/9/03 from which benefit is being claimed for this application under:

35 U.S.C. Section  119(e),  
 120,  
 121,  
 365(c),

and which status as a small entity is still proper and desired.

- A copy of the statement in the prior application is included.

Filing Fee Calculation (50% of A, B or C above) \$ 385.

NOTE: Any excess of the full fee paid will be refunded if a small entity status is established refund request are filed within 2 months of the date of timely payment of a full fee. The two-month period is not extendable under § 1.136. 37 C.F.R. § 1.28(a).

**REQUEST FOR INTERNATIONAL-TYPE SEARCH  
(37 C.F.R. § 1.104(d))**

(complete, if applicable)

9.  Please prepare an international-type search report for this application at the time when national examination on the merits takes place.

**FEE PAYMENT BEING MADE AT THIS TIME**

10.  Fee for conversion of a provisional application to a nonprovisional application set forth in 37 C.F.R. § 1.17(i) \$ 130.00  
 Filing fee \$ 515,

(This and the surcharge required by 37 C.F.R. § 1.16(e) can be paid subsequently.)

- Recording assignment (\$40.00; 37 C.F.R. § 1.21(h))  
(See attached "COVER SHEET FOR ASSIGNMENT ACCOMPANYING NEW APPLICATION.") \$ \_\_\_\_\_  
 Petition fee for filing by other than all the inventors or person on behalf of the inventor where inventor refused to sign or cannot be reached (\$130.00; 37 C.F.R. §§ 1.47 and 1.17(i)) \$ \_\_\_\_\_  
 Fee for international-type search report (\$40.00; 37 C.F.R. § 1.21(e)) \$ \_\_\_\_\_

NOTE: 37 C.F.R. § 1.21(l) establishes a fee for processing and retaining any application that is abandoned for failing to complete the application pursuant to 37 C.F.R. § 1.53(f) and this, as well as the changes to 37 C.F.R. § 1.53 and 1.78(a)(1), indicate that in order to obtain the benefit of a prior U.S. application, either the basic filing fee must be paid, or the processing and retention fee of § 1.21(l) must be paid, within 1 year from notification under § 53(f).

Total Fees Enclosed \$ 515.00

(Request For Conversion of Provisional to Nonprovisional Application (37 C.F.R. § 1.53(c)(3)) [23-10]  
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**METHOD OF PAYMENT OF FEES**

11.  Check in the amount of \$ 515.00

Charge Account No. \_\_\_\_\_ in the amount of \$ \_\_\_\_\_

A duplicate of this transmittal is attached.

*NOTE: Fees should be itemized in such a manner that it is clear for which purpose the fees are paid. 37 C.F.R. § 1.22(b).*

Charge Credit Card the sum of \$ \_\_\_\_\_

(Credit Card Payment Form (PTO-2038) attached)

**AUTHORIZATION TO CHARGE ADDITIONAL FEES**

**WARNING:** If no filing fees are to be paid on filing, the following items should not be completed.

**WARNING:** Accurately count claims, especially multiple dependent claims, to avoid unexpected high charges, if extra claim charges are authorized.

12.  The Commissioner is hereby authorized to charge the following additional fees by this paper and during the entire pendency of this application to Account No. \_\_\_\_\_

37 C.F.R. § 1.16(a), (f) or (g) (filing fees)

37 C.F.R. § 1.16(b), (c) and (d) (presentation of extra claims)

*NOTE: Because additional fees for excess or multiple dependent claims not paid on filing or on later presentation must only be paid or these claims cancelled by amendment prior to the expiration of the time period set for response by the PTO in any notice of fee deficiency (37 C.F.R. § 1.16(d)), it might be best not to authorize the PTO to charge additional claim fees, except possibly when dealing with amendments after final action.*

37 C.F.R. § 1.16(e) (surcharge for filing the basic filing fee and/or declaration on a date later than the filing date of the application).

37 C.F.R. § 1.17(a)(1)-(5) (extension fees pursuant to § 1.136(a)).

37 C.F.R. § 1.17 (application processing fees).

*NOTE: "A written request may be submitted in an application that is an authorization to treat any concurrent or future reply, requiring a petition for an extension of time under this paragraph for its timely submission, as incorporating a petition for extension of time for the appropriate length of time. An authorization to charge all required fees, fees under Section 1.17, or all required extension of time fees will be treated as a constructive petition for an extension of time in any concurrent or future reply requiring a petition for an extension of time under this paragraph for its timely submission. Submission of the fee set forth in Section 1.17(a) will also be treated as a constructive petition for an extension of time in any concurrent reply requiring a petition for an extension of time under this paragraph for its timely submission." 37 C.F.R. Section 1.136(a)(3).*

37 C.F.R. § 1.18 (issue fee at or before mailing of Notice of Allowance, pursuant to 37 C.F.R. § 1.311(b))

*NOTE: Where an authorization to charge the issue fee to a deposit account has been filed before the mailing of a Notice of Allowance, the issue fee will be automatically charged to the deposit account at the time of mailing the notice of allowance. 37 C.F.R. Section 1.311(b)).*

*NOTE: 37 C.F.R. Section 1.28(b) requires "Notification of any change in status resulting in loss of entitlement to small entity status must be filed in the application . . . prior to paying, or at the time of paying, . . . issue fee." From the wording of 37 C.F.R. Section 1.28(b), (a) notification of change of status must be made even if the fee is paid as "other than a small entity" and (b) no notification is required if the change is to another small entity.*

## INSTRUCTIONS AS TO OVERPAYMENT

NOTE: ". . .Amounts of twenty-five dollars or less will not be returned unless specifically requested within a reasonable time, nor will the payer be notified of such amounts; amounts over twenty-five dollars may be returned by check or, if requested, by credit to a deposit account." 37 C.F.R. § 1.26(a).

13.  Credit Account No. \_\_\_\_\_  
 Refund

Reg. No.: 19,877

  
SIGNATURE OF PRACTITIONER

LaValle D. Ptak

(type or print name of practitioner)

Tel. No.: (480) 419-9019

28435 N. 42nd Street

P.O. Address

Customer No.:

Cave Creek, Arizona 85331

Incorporation by reference of added pages

(check the following item if the application in this transmittal claims the benefit of prior U.S. application(s) (including an international application entering the U.S. stage as a continuation, divisional or C-I-P application) and complete and attach the ADDED PAGES FOR NEW APPLICATION TRANSMITTAL WHERE BENEFIT OF PRIOR U.S. APPLICATION(S) CLAIMED)

Plus Added Pages for New Application Transmittal Where Benefit of Prior U.S. Application(s) Claimed

Number of pages added \_\_\_\_\_

Plus Added Pages for Papers Referred to in Item 4 Above

Number of pages added \_\_\_\_\_

Plus added pages deleting names of inventor(s) named on prior application(s) who is/are no longer inventor(s) of the subject matter claimed in this application.

Number of pages added \_\_\_\_\_

Plus "Assignment Cover Letter Accompanying New Application"

Number of pages added \_\_\_\_\_

Statement Where No Further Pages Added To This Transmittal

This transmittal ends with this page.

(Request For Conversion of Provisional to Nonprovisional Application (37 C.F.R. § 1.53(c)(3)) [23-10]  
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